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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.              | CONFIRMATION NO.       |
|--|-------------|----------------------|----------------------------------|------------------------|
| 10/657,145   | 09/09/2003  | David Alexander      | IMMR-IMD0002D<br>(034701-005)    | 1899                   |
| 60140 7590 09/30/2008<br>IMMERSION -THELEN LLP<br>P.O. BOX 640640<br>SAN JOSE, CA 95164-0640 |             |                      | EXAMINER<br>MUSSELMAN, TIMOTHY A |                        |
|  |             |                      | ART UNIT<br>3714                 | PAPER NUMBER           |
|  |             |                      | MAIL DATE<br>09/30/2008          | DELIVERY MODE<br>PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|                              |                                      |   |  |
|------------------------------|--------------------------------------|---|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/657,145 | <b>Applicant(s)</b><br>ALEXANDER ET AL. |  |
|                              | <b>Examiner</b><br>TIMOTHY MUSSELMAN | <b>Art Unit</b><br>3714                 |  |

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period **will** apply and **will** expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply **will**, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 05 August 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 12-20,34,35,37 and 38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 12-20 is/are allowed.
- 6) ☒ Claim(s) 34-35,37-38 is/are rejected.
- 7) ☒ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                 | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                        | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Status of Claims***

In response to applicant's after final submission dated 8/5/2008, prosecution is reopened, and claims 12-20, 34-35, and 37-38 are currently pending.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of the relevant portion of 35 U.S.C. 103 that forms the basis for the rejections made in this section of the office action;

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

**Claims 34-35 and 37-38 are rejected under 35 U.S.C. 103(a) as being obvious over the combination of Bailey (US 5,800,179) and Humes et al. (US 1,889,330).**

**Regarding claims 34-35 and 37-38,** Bailey discloses a capture mechanism configured to engage a peripheral device, and a sensing assembly to detect movement of the peripheral device while engaged. See col. 5: 25-35. Bailey fails to disclose any details pertaining to the clamping apparatus. Thus, one of ordinary skill in the art would have been motivated to consider systems directed towards quick and convenient clamping of peripheral objects. Hume discloses a device for a screwdriver which automatically grasps and retains the screw with a plurality of jaws by actuating a lever device (sleeve) in response to relative movement of the device and the screw, and also automatically releases the screw in response to

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a second relative movement of the device and the screw. See page 1, col. 1: 43-46, and also page 2, col. 2: 1-14. It would have been obvious to one of ordinary skill in the art at the time of the invention to utilize this type of clamping mechanism in the system of Bailey in order to improve the device using clamping mechanisms known in the art as taught by Humes, to allow for the quick connection of various surgical tools.

### ***Allowable Subject Matter***

**Claims 12-17 are indicated as allowable**, at least because the prior art does not teach or suggest a tubular clamping mechanism wherein an actuator urged against the clamping mechanism maintains the grasping member in an open position until an inserted peripheral device pushes the actuator to a second position, thereby allowing the grasping member to secure around the device, and wherein such a device is disposed within a positional sensing assembly.

**Claims 18-20** remain allowed as previously indicated.

**The allowability of claims 34-35 and 37-38** is withdrawn in view of the newfound reference to Humes et al. (US 1,888,330),

### ***Response to Arguments***

Applicant's arguments dated 8/5/2008 have been fully considered, but are moot in view of the new grounds of rejection. Prosecution is reopened due the withdrawal of the previously indicated allowability of claims 34-35 and 37-38.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to TIMOTHY MUSSELMAN whose telephone number is (571)272-1814. The examiner can normally be reached on Mon-Thu 6:00AM - 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Pezzuto can be reached on (571)272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/T. M./  
Examiner of Art Unit 3714

/Xuan Thai/  
Supervisory Primary Examiner  
Art Unit 3714